



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/713,333   | 11/13/2003  | Steven P. Barton     | 112703-295          | 9875             |
| 29156  | 7590        | 12/17/2004           | EXAMINER            |                  |
| BELL, BOYD & LLOYD LLC<br>P. O. BOX 1135<br>CHICAGO, IL 60690-1135 |             |                      | FRECH, KARL D       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2876                |                  |

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,333

Applicant(s)

BARTON ET AL.

Examiner

Karl D Frech

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 16-24, 26-43, 69-84, 90-93 and 102-110 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-24, 26-43, 69-84, 90-93 and 102-110 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Applicant's response received September 21, 2004 has been considered.
2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 1-14, 16-24, 26-43, 69-84, 90-93 and 102-110 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Addy et al 6,550,582 in view of NESTLER 4,645,036. Addy discloses a typical supermarket checkout counter with a pre-scan area 12, and itemization area 14, a payment area 16 and a post-scan area 18. There is disclosed a belt assembly 20, a terminal base 28 which has a customer side and a rear

side. There is disclosed a scanner 34 for scanning typical identification codes such as UPC bar codes, and a product scale 36. There is disclosed a payment area 16 which includes a card reader and a keypad, a currency acceptor, a coin acceptor, and an optional coupon acceptor. Currency, coin and receipt dispensers are also disclosed. (see fig 1.) The bill dispenser can be considered to be a product dispenser as the bill or product is dispensed, however, this is not the intent of the bill dispenser. Nestler discloses a product dispenser at a checkout counter and its associated control elements. (see col 5 lines 52-60, fig 1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the product dispenser of Nestler with the checkout counter of Addy. As clearly taught by Nestler, this would be useful for discouraging theft and provide easy access to the checkout clerk or store patron at checkout (see col 5 lines 45-50). Nestler does not disclose that the product dispenser is integral with the checkout counter of Addy. However, to make the two integral would have been found obvious by one of ordinary skill in the art. Doing so would make the unit more compact and more readily maintained.

6. Applicant's arguments filed 9/21/04 have been fully considered but they are not persuasive. Applicant argues that the rejection is not proper because Nestler does not "provide easy access to the ... store patron at checkout", and that Nestler's device requires a retail operator. The examiner does not disagree that Nestler requires a retail operator. However, the examiner respectfully disagrees that this renders the rejection invalid. Applicant is reminded that it is what is suggested by the combination of the references combined, and in the general knowledge of a person of ordinary skill, that

forms the basis of rejection. Addy discloses the self service shopping apparatus. Addy and Nestler are both checkout terminals in retail shopping establishments. For the reasons as set forth in the rejection above, the examiner maintains that the references are properly combined to encompass the currently claimed invention.

7. Applicant argues that the communication means is not taught in the references. A communication means is specifically recited in column 8 lines 61+ of Nestler. The examiner points out that the current claims are apparatus claims. The intended use in these apparatus claims does not carry patentable weight.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. Applicant further generically alleges that the examiner has not provide motivation to combine the references, and that the references teach away from each other. The examiner respectfully disagrees. As seen in the rejection above, the examiner has in fact provided motivation. Although the applicant states that Addy teaches self service and Nestler teaches operator service, the applicant has not provided specific argument as why the references teach away from each other. Therefore, since the examiner has

provided motivation, and since there are no specific argument as why the references teach away from each other, the examiner maintains the rejection.


10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl D Frech whose telephone number is (571) 272-2390. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karl D Frech  
Primary Examiner  
Art Unit 2876

\*\*\*